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WARD KRAFT, INC. P.O. BOX 938 FORT SCOTT, KS 66701	

  

EXAMINER	
BATTULA, PRADEEP CHOUDARY	

  

ART UNIT	PAPER NUMBER
3722	

  

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

ED

**Office Action Summary****Application No.**

10/689,944

**Applicant(s)**

CRUM, JESSE D.

**Examiner**

Pradeep C. Battula

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 16-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date August 2, 2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

**This action is in reply to the response filed on July 10, 2006**

#### ***Election/Restrictions***

Applicant's election without traverse of Claims 1 – 15 in the reply filed on July 10, 2006 is acknowledged.

#### ***Claim Rejections - 35 USC § 112***

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant discloses a first and second property for the substrates but it is not clear to what defines these properties.

Claims 2 – 15 are further rejected as being dependent from Claim 1.

#### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the cohesive or adhesive patterns provided with indicia must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet,

and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1 – 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sauerwine et al. (Sauerwine; U.S. 5,289,972) in view of Voshall et al. (Voshall; U.S. 4,709,397).

In regards to Claims 1 and 9, Sauerwine discloses a business form, comprising; a first substrate 19, 21 having a first property and having first and second longitudinal side edges and first and second transverse end edges (Column 3, Lines 30 – 39; Figure 2, Items 19, 21); a second substrate 20 having a second property (cut out 30), distinct from said first property, said second substrate being joined to said first substrate along

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one of said side or end edges (Column 3, Lines 62 – 66); at least one removable element 32 provided with one of said first and second substrates (Column 3, Lines 62 – 68; Figure 3, Item 32); a plurality of patterns 40, 46 – 51 disposed between one of said sides or end edges of at least one of said first and second substrates said plurality of patterns being applied to said at least one of said first and second substrates and said plurality of patterns spaced from one another at least one of said plurality of patterns connecting said first substrate to said second substrate; and wherein said plurality of patterns with said first and second substrates create a substantially planar business form assembly having at least one removable element (Column 4, Lines 22 - 26, 34 – 46; Figure 2, Items 40, 49-51; Figure 1, Items 46-48; Figures 4, 5).

Sauerwine does not disclose a coating applied to at least one of said first and second substrates, said coating anchoring toner, ink, adhesive, cohesive and combinations thereof to said at least one of said first and second substrates.

Voshall discloses of a textured, which the examiner considers roughened, cohesive anchoring coating 46 on a substrate (Column 2, Lines 27 – 31; Column 3, Lines 62 – 66; Figure 5, Item 46). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use the anchor and cohesive 48, 50 coatings of Voshall in Sauerwine in order to create a tamper evident business form/envelope (Column 2, Lines 18 – 23; Voshall).

In regards to Claims 2 and 3, as applied to Claim 1, Sauerwine modified by Voshall further discloses wherein said patters are composed of continuous (40), discontinuous (46-51), segmented (46-51), uninterrupted arrangement (40) and

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combinations thereof wherein the patterns are strips, dots, geometric shapes, printed designs and combinations thereof (Column 4, Lines 22 - 26, 34 - 46; Figure 2, Items 40, 49-51; Figure 1, Items 46-48; Figures 4, 5; Sauerwine).

In regards to Claim 4, as applied to Claim 1, Sauerwine modified by Voshall discloses the claimed invention except for the coating having at least a first component between .01% and 90% by weight of an absorbing agent. However, it is well known that anchoring coatings are well known to have absorbing agents for several items such as oxygen and UV light therefore it would have been obvious to a person having ordinary skill in the art to have an absorbing agent in the coating having at least .01% by weight because it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945).

In regards to Claim 5, as applied to Claim 1, Sauerwine modified by Voshall further discloses wherein said substrates are selected from a group including cellulosic, plastics, metal based films, and combinations thereof (Column 3, Lines 20 - 21; Sauerwine).

In regards to Claim 6, as applied to Claim 1, Sauerwine modified by Voshall further discloses wherein the spacing between said plurality of patterns extends less than an area between of said side edges (Figure 1, Items 46-48; Sauerwine) or said end edges (Figure 2, Items 40, 49 - 51; Sauerwine).

In regards to Claim 7, as applied to Claim 1, Sauerwine modified by Voshall further discloses wherein a plurality of said planar business form assemblies when placed in a stack will have a substantially square, cube or rectangular formation (Figure 3; Sauerwine).

In regards to Claim 8, as applied to Claim 1, Sauerwine modified by Voshall further discloses wherein said plurality of patterns are selected from a group including glassine, machine glazed paper, highly calendared paper, starch or wax based coatings, silicone coatings, pigment less coatings, ammonia based coatings, alcohol based coatings, polyethylene, polyester based materials and combinations thereof (Column 2, Lines 27 – 45; Voshall – since the anchor portion is translucent or opaque and when bonded with the cohesive pattern the same translucent or opaque appearance is still there, it is inherent that one of the patterns is pigment less; Figure 5-pigment less message).

In regards to Claim 10, as applied to Claim 1, Sauerwine modified by Voshall further discloses wherein each of said first and second substrates has at least one pattern disposed thereon (Figure 1, Items 46 – 48; Sauerwine; Figure 2, Items 40, 49 – 51).

In regards to Claim 11, as applied to Claim 1, Sauerwine modified by Voshall further discloses wherein said plurality of patterns may be provided with indicia (Column 4, Lines 3 – 16; Figure 5).

In regards to Claim 12, as applied to Claim 1, Sauerwine modified by Voshall further discloses wherein said plurality of patterns decrease surface affinity between

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said planar business card assemblies since the patterns of one assembly will not be in direct contact with a pattern from another assembly.

In regards to Claim 13, as applied to Claim 4, Sauerwine modified by Voshall further discloses wherein said coating includes a second component including a pigment less material (Column 2, Lines 27 – 45; Voshall – since the anchor portion is translucent or opaque and when bonded with the cohesive pattern the same translucent or opaque appearance is still there, it is inherent that one of the patterns is pigment less; Figure 5- pigment less message).

In regards to Claim 14, as applied to Claim 1, Sauerwine modified by Voshall further discloses wherein said element removable from the form assembly is selected from a group including cards, tags, coins, chips, labels, and combinations thereof (Column 3, Lines 62 – 68; Figure 3, Item 32).

2. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sauerwine in view of Voshall and Schmidt (5,172,938).

In regards to Claim 15, as applied to Claim 1, Sauerwine modified by Voshall does not disclose wherein said removable element is a self laminating card.

Schmidt discloses a business form having an Identification card 28 which is removable from the form wherein the card has a transparent film wherein the card is self laminating (Column 2, Lines 1 – 27; Figures 4 – 8). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide Sauerwine modified by Voshall's form with Schmidt's form by using Schmidt's self laminating card in order to provide a singly ply business form/mailer with a card



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(Column 1, Lines 10 – 13, 16 – 20; Schmidt). Please refer to Schmidt (4,982,894 as it teaches a business form/mailer with a business card).

**Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Umata, Moriguchi, and Komiya discuss the absorbing agents as well.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pradeep C. Battula whose telephone number is 571-272-2142. The examiner can normally be reached on Monday - Thursday 7:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica S. Carter can be reached on 571-272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PCB  
Patent Examiner  
May 31, 2007

  
MONICA CARTER  
SUPERVISORY PATENT EXAMINER